

**REMARKS**

In reply to the Final Office Action, Applicant has amended claims 1, 15 and 31. No new matter has been introduced by these amendments. Claims 1-3, 6, 8-17, 20 and 22-33 are currently under examination.

In the Final Office Action, the Examiner rejected claims 1-3, 6, 8-17, 20 and 22-33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,317,718 to Fano ("Fano") in view of U.S. Patent No. 6,647,257 to Owensby ("Owensby") further in view of U.S. Patent No. 6,920,319 to Knuttson et al. ("Knuttson").<sup>1</sup>

**I. Section 103(a) Rejections**

Applicant respectfully traverses the Section 103(a) rejection of claims 1-3, 6, 8-17, 20 and 22-33 because Fano, Owensby, and Knuttson, taken alone or in combination, fail to disclose or suggest every claim element in these claims. Applicant respectfully submits that the Examiner failed to provide rationales to support a conclusion of obviousness in this case, because the Office Action does not properly ascertain the scope and content of the prior art, and there are significant differences between the teachings of the alleged prior art references and the claims. (M.P.E.P. § 2141(II, III), 8<sup>th</sup> ed., rev'd Sep. 2007 ("The gap between the prior art and the claimed invention may not be 'so great as to render the [claim] nonobvious to one reasonably skilled in the art.'" (internal citations omitted)).

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<sup>1</sup> While Owensby is not identified on page 2 of the Final Office Action as one of the references cited under the Section 103(a) rejection, Owensby is cited in the actual text of the rejection on page 3 of the Final Office Action.

Claim 1, as amended, recites a method for delivering context-sensitive advertising to a user that includes, *inter alia*, “continuously updating [a] location-unique user profile, utilizing [a] context engine, wherein the location-unique user profile is based on access to advertisements, [a] mobile wireless device’s location at time of access to advertisements, and the mobile wireless device’s access of network sites indicative of user preferences,” “associating the location of the mobile wireless device and a landmark in [a] profile database,” and “selecting advertisements from an advertisement database based on the identifier, the state, the location, the accessed location-unique user profile, and [a] landmark associated with the mobile wireless device, utilizing the context engine.” Applicant respectfully submits that none of the references relied on by the Examiner teaches, discloses or otherwise suggests any of the listed features as recited in claim 1, among others.

Fano is directed to a system that customizes and forwards offer information to a user based on items of interest obtained from the user. (Abstract; col. 2, lines 41-54). For example, a user may first enter a merchandise as an item of interest, and the Fano system, acting as a shopping agent, presents offers information of the merchandise to the user. (Figs. 9, 27; col. 27, lines 11-29; col. 52, lines 17-31). While the Examiner alleged that Fano discloses “continuously updating . . .,” the Examiner could not point to any disclosure in Fano, unlike what she did with respect to some recitations of claim 1. The lack of any citation suggests that, contrary to the Examiner’s allegation, Fano fails to teach or otherwise suggest the above recitation of amended claim 1.

Indeed, while Fano discloses an “Awareness Machine [that] reflects a constantly updated state-of-the-owner's-world by continually receiving a wireless trickle of information,” Fano fails to teach or otherwise suggest the claimed “context engine.” (Col. 36, lines 51-53). Claim 1, as amended, recites a context engine that “continuously update[s] . . . based on access to advertisements, [a] mobile wireless device’s location at time of access to advertisements, and the mobile wireless device’s access of network sites indicative of user preferences.” However, as stated in Fano, the Awareness Machine’s updated information “consists of mail messages, news that meets each user’s preferences, schedule updates, background information on upcoming meetings and events, as well as weather and traffic.” (Col. 36, lines 53-57). In other words, the Awareness Machine’s updated information is not “based on access to advertisements, [a] mobile wireless device’s location at time of access to advertisements, and the mobile wireless device’s access of network sites indicative of user preferences.” Thus, Fano fails to teach or otherwise suggest the claimed “context engine.” It follows that because Fano fails to teach or otherwise suggest the claimed “context engine,” Fano also fails to teach “continuously updating . . . utilizing [a] context engine” and “selecting advertisements . . . utilizing the context engine.”

In addition, the Examiner did not allege, nor does Fano disclose “associating the location of the mobile wireless device and a landmark in [a] profile database,” as recited in amended claim 1. Accordingly, Fano fails to disclose “continuously updating [a] location-unique user profile, utilizing [a] context engine, wherein the location-unique user profile is based on access to advertisements, [a] mobile wireless device’s location

at time of access to advertisements, and the mobile wireless device's access of network sites indicative of user preferences," "associating the location of the mobile wireless device and a landmark in [a] profile database," and "selecting advertisements from an advertisement database based on the identifier, the state, the location, the accessed location-unique user profile, and [a] landmark associated with the mobile wireless device, utilizing the context engine," as recited in amended claim 1. Owensby and Knuttson, which are only cited for their alleged disclosure of "transmitting a call signal," and "a sever that can 'push . . . location dependent information to . . . wireless devices," respectively, fail to remedy the deficiencies of Fano. (FOA at 3). Therefore, Fano, Owensby, and Knuttson, taken alone or in combination, fail to disclose or otherwise suggest at least the above listed features as recited in claim 1, as amended.

Applicant respectfully submits that because Fano, Owensby, and Knuttson all fail to disclose or otherwise suggest at least one claimed feature, the Final Office Action did not properly ascertain the scope and content of the alleged prior art, and there are significant differences between the teachings of the alleged prior art references and the claims. For at least these reasons, independent claim 1 and claims 2-3, 6, 8-14 and 32 that depend therefrom are in condition for allowance. Claims 2-3, 6, 8-14 and 32 are also allowable because they recite additional features not taught nor suggested by the cited art.

Independent claims 15, 29 and 31, while having scopes different than claim 1, include similar recitations to claim 1. Therefore, for at least the same reasons as set forth with respect to claim 1, claims 15, 29 and 31, and claims 16-17, 20, 22-28, 30 and

33 that depend therefrom are also in condition for allowance. Dependent claims 16-17, 20, 22-28, 30 and 33 are also allowable because they recite additional features not taught nor suggested by the cited art.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-3, 6, 8-17 and 22-33 under 35 U.S.C. § 103(a).

## **II. Conclusion**

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-3, 6, 8-17, 20 and 22-33 in condition for allowance. Applicant submits that the proposed amendments of claims 1, 15 and 31 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

The Final Office Action makes statements characterizing the claims and the references. Applicant does not subscribe to any such characterizations, whether they are expressly mentioned in this response, or not.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments as to the application of the art against the application. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant submits that claim 1-3, 6, 8-17, 20 and 22-33, as amended, are neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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